

REMARKS

After entry of this Amendment, claims 35-50 are pending. Claims 48-50 have been added. Claim 48, which depends on claim 35, recites that “the at least one marking effector is separate from the at least one injury effector.” Claim 49, which depends on claim 35, recites that “the position marker created by the at least one marking effector is at a third tissue location different from the first tissue location and the second tissue location.” Claim 50, which depends on claim 38, recites that “the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by the control structure.” Support for claims 48-50 is found, for example, at pages 13 and 16 of the specification as filed. No new matter has been added.

Rejections under 35 U.S.C. § 102(e)

Claims 35-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,264,650 to Hovda *et al.* (“Hovda”). Applicant respectfully traverses this rejection.

Claims 35 and 47 recite “at least one marking effector located at the distal end of the elongate shaft for creating a position marker to indicate treated tissue.” The Examiner alleges that element 104 of Hovda serves as both an injury effector and as a marking effector. Applicant respectfully disagrees. Hovda does not disclose, teach, or suggest a marking effector. While Hovda discloses a plurality of electrodes capable of applying electrical energy to a target, Hovda does not disclose that these electrodes create a position marker to indicate treated tissue. While Applicant’s specification teaches that a position marker *may* occur as a side effect of use of the injury effector, injury does not necessarily create a position marker. Thus, to the extent the Examiner’s position may have been implying a marking effector is inherent in the Hovda device, Applicant respectfully disagrees. The mere fact that the electrodes in the Hovda device *may* create a position marker is not sufficient for Hovda to anticipate claim 35 or 47.

The Examiner also asserts that it would be obvious to one of ordinary skill in the art to include radiopaque or MRI markers in the Hovda device to ensure proper placement in the body. Even if the Examiner’s assertion were correct, and Applicant does not concede this to be the case, markers in the device to ensure proper placement of the device do not substitute for a marking effector which creates a position marker on the tissue. Markers on the device

would enable one to more easily maneuver the device, but a position marker on the tissue allows one to know the position to which one desires to maneuver the device.

Because Hovda fails to disclose, teach, or suggest each and every element of independent claims 35 and 47, Applicant respectfully submits that the rejections of claims 35 and 47 should be withdrawn. Because dependent claims 36-46 depend directly or indirectly from independent claim 35, Applicant respectfully submits that the rejections of claims 36-46 should be withdrawn for at least the same reason that the rejection of claim 35 should be withdrawn.

New claims 48-50

Claims 48-50 depend directly or indirectly from independent claim 35. Because Hovda does not disclose, teach, or suggest all of the elements of independent claim 35, claims 48-50 are allowable for at least the same reason that claim 35 is allowable.

In addition, claim 48 recites that “the at least one marking effector is separate from the at least one injury effector.” Hovda does not disclose, teach, or suggest a marking effector separate from an injury effector. Even if the Examiner correctly identified element 104 of Hovda as a marking effector, which Applicant does not believe to be the case, Hovda does not disclose, teach, or suggest a marking effector separate from the at least one injury effector, because the Examiner also identified element 104 as the injury effector. Therefore, claim 48 is allowable for at least this additional reason.

Claim 49 recites that “the position marker created by the at least one marking effector is at a third tissue location different from the first tissue location and the second tissue location.” Hovda does not disclose, teach, or suggest a position marker at a third tissue location. Even if the Examiner correctly identified element 104 of Hovda as a marking effector, which Applicant does not believe to be the case, because the Examiner also identified element 104 as the injury effector, the device of Hovda would not create a position marker at a tissue location different from the tissue location of the injury. Therefore, claim 49 is allowable for at least this additional reason.

Claim 50 recites that “the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by the control structure.” Even if the Examiner correctly concluded that the electrodes of Hovda serve to create injury and as a side effect create a position marker, which Applicant does not believe necessarily to be the case,

the device of Hovda would not be capable of sequentially actuating an injury effector and a marking effector. Therefore, claim 50 is allowable for at least this additional reason.

CONCLUSION

It is believed that claims 35-50 are in condition for allowance. Should the Examiner not agree with any of Applicant's positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

No fee is believed due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

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Respectfully submitted,



58,442

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